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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,150

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Sheldon H. Foss JR.

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02/22/2010

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EXAMINER

ROSEN, ELIZABETH H

ART UNIT

PAPER NUMBER

3684

MAIL DATE

DELIVERY MODE

02/22/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/646,150

**Applicant(s)**

FOSS ET AL.

**Examiner**

ELIZABETH H. ROSEN

**Art Unit**

3684

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8-11, 13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-11, 13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the Amendment and Response filed on December 17, 2009.
2. Claims 1-4, 6, 8, 9, 11, 13, and 15-21 have been amended.
3. Claims 5, 7, 12, and 14 have been canceled.
4. Claims 1-4, 6, 8-11, 13, and 15-23 are currently pending and have been examined.

### ***Previous Claim Objections***

5. The previous objection to Claim 11 is withdrawn in light of Applicant's amendments.

### ***Previous Claim Rejections - 35 USC § 101***

6. The previous rejection of Claims 11, 13, and 15-20 under 35 U.S.C. 101 are withdrawn in light of Applicant's amendments.

### ***Previous Claim Rejections - 35 USC § 112, Second Paragraph***

7. The previous rejections of Claims 1-4, 6, 8-11, 13, and 15-23 under the second paragraph of 35 U.S.C. 112 are withdrawn in light of Applicant's amendments.

### ***Response to Arguments***

8. Applicant's arguments regarding the rejection under the first paragraph of 35 U.S.C. 112 have been considered, but they are not persuasive. Applicant should refer to the rejection below for an explanation of this rejection.

***Claim Rejections - 35 USC § 112, First Paragraph***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 1-4, 6, 8-11, 13, and 15-23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims have been amended to include a processing system. Because the specification does not include any description of the claimed invention being performed by a processing system, this is new matter.

11. There is no indication in the specification that this invention is to be performed by a processing system. Likewise, the specification filed with the provisional application (60/466,494) does not explain the invention being performed by a processing system. However, a document that was filed with the provisional application does include a computer. Page 17 of this document states that "[t]he James/ Foss system is a collection of integrated computer softwares and proprietary algorithms, methods of work, business processes, and risk models that enable the analysis/issuance/distribution/monitoring of an integrated credit product that extends credit through host based stored value and an unsecured credit line." Page 17 further states "[t]he James/Foss system gives the service provider the ability to underwrite and integrate an extension of credit to a consumer through purchase/acquisition of a host based stored value or financial transaction vehicle." The page further includes a drawing that has a processing system. Nowhere does this document suggest that a computer or processor is used to perform the claimed invention. Furthermore, the specification of the non-provisional application does not refer to this document or explain how the computer shown in this document performs the claimed invention. In order for the provisional and non-provisional applications to include sufficient support for amendments made for 35 U.S.C. 101, they must describe the claimed embodiments as being performed by a computer or processor. More specifically, with regard to the method claims, the inventive features must be performed by a computer or processor. The mere mention of a computer that is used to perform non-claimed tasks is insufficient to provide support for the claims.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Rosen whose telephone number is 571-270-1850. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm, ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth H Rosen/  
Examiner, Art Unit 3684

/Kambiz Abdi/  
Supervisory Patent Examiner, Art Unit 3684